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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,133	09/26/2003	Stephen A. Ewald	EWAL-0002	6111
49358 7590 03/17/2008 CARLTON FIELDS, PA 1201 WEST PEACHTREE STREET 3000 ONE ATLANTIC CENTER ATLANTA, GA 30309				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/672,133

**Applicant(s)**

EWALD, STEPHEN A.

**Examiner**

MARK FADOK

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 8/23/2007 which was received 11/30/2007. Acknowledgement is made to the amendment to claims 1, 9 and 12 which obviates the USC 112 rejection. The examiner has carefully considered applicants arguments, but does not find them persuasive. Therefore the previous rejection is restated below:

### ***Examiner's Note***

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 1-13, 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kesling et al. (US 2002/0132575 A1) in view of Borovoy (US 20030204446).**

Kesling et al. discloses a method for purchasing goods and services linked with broadcast media (par. 0039 and Figs. 1-3).

The method comprises receiving at least one broadcast receiver a broadcast media including information relating to goods and services that can be purchased by persons receiving the media; selectively recording purchase data at the broadcast receiver for a good and service that a person purchases relating to the broadcast media; sending the purchase data from the broadcast receiver to at least one server; receiving the purchase data at the at least one server; and verifying the purchase data from the broadcast receiver at the at least one server.

Kesling et al. references U.S. application serial number 09461,699 and incorporates such application by reference. See Kesling et al. at paragraphs [0007]-[0010]. Accordingly, the disclosure of such application forms part of the Kesling et al. disclosure as of the date of the incorporation by Kesling et al.

Kesling et al. builds upon the system and method disclosed by '699. The '699 disclosure states that "the receiver is adapted to receive an input from the user by which the user is able to signal an interest in purchasing a selection of music or data being played and/or displayed" ('699 at page 2, last line-page 3, line 2). Accordingly, claims 1, 9, 12 (as amended to recite "each receiver further selectively receiving a purchase request and recording purchase data for goods and services that a person purchases relating to the broadcast media" (claim 1, for example, and similar language in claims 9 and 12), is anticipated by Kesling et al.

Kesling teaches sending purchase related information back to the server using a one click method (para 0065), but does not specifically mention that the purchase is accomplishable without further interaction from the person. Borovoy teaches using the Amazon.com one click method to send purchase data from a portable device to a website in a one click manner (para 0017). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Kesling providing a one-click method of ordering as taught by Borovoy, because it has been well establish that impulse buying is responsible for many sales and the removing of steps required to consummate the sale further provides for a impulse sale.

Regarding claim 3: the purchase data may be transmitted at a predetermined location (par. 0043).

Regarding claims 5 and 6, respectively: Kesling discloses that the broadcast media may be an advertisement (information about the purchase of a particular good or service) or a song (no information about the purchase of such song).

Regarding claims 7 and 8, respectively: the broadcast receiver may comprise either a single device (par. 0041) or an "intermediate transfer device" may be additionally employed as a purchase selection device (par. 0042).

Applicant's attention is directed to the Kesling et al. disclosure regarding "low" and "high" power wireless transmitters (600 and 700, respectively).

In regards to claim 20, the combination of Kesling and Borovoy teach where in the two devices are separate (Kesling 00042).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kesling et al. (US 2002/0132575 A1) in view of Borovoy and further in view of Official Notice regarding secure communication channels.

Kesling et al. does not disclose a secure communication channel. However, it is notoriously well-known to employ secure communication channels when endeavoring to conduct transactions of the type disclosed by Kesling. One of ordinary skill in the art would have modified the Kesling method to have included sending purchase data via a secure channel in order that confidential information relative to the customer or the customer's account is not readily intercepted.

### ***Response to Arguments***

Applicant argues that the use of Patsiokas at page 4 of the previous office action is an error. The examiner disagrees and directs attention to MPEP 2127[R-6] which states "matter of an abandoned application, including both provisional and nonprovisional applications, referred to in a prior art U.S. patent >or U.S. patent application publication< may be relied on in a 35 U.S.C. 102(e) rejection based on that patent >or patent application publication< if the disclosure of the abandoned application is actually included or incorporated by reference in the patent. Compare *In re Lund*, 376 F.2d 982, 991, 153 USPQ 625, 633 (CCPA 1967)". As is clearly stated a USC 102(e) rejection can be maintained if the reference is incorporated in the base reference in its entirety as is evident in the Kesling reference para 007. Since a USC 102 rejection can be maintained then there is no combination and only the Kesling reference is necessary in the rejection header. Applicant was provided with the patent 7,010,263 which was cited in the accompanying PTO 892 as a courtesy. Since all applications that

are published as Patents have the prosecution history open to the public it is applicant's responsibility to acquire the 09/461,699 application.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Flash memory or wireless technology) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the examiner has read the disclosure of both Kesling and Patsiokas and has determined that the two technologies may be used together to accomplish the results of the instant invention by receiving on a wireless device and transferring information to a flash card receiver for transmission to a hub. Please note that the result is the same regardless of how the information is received. Applicant's specification also indicates these two methods of ordering (Flash memory or wireless technology) as is depicted in FIG 2. Additionally, applicant does not limit the receiving device to a wireless device so applicant's argument appears to be moot and claims 8,9 and 20 appear to be claiming the flash memory technology where information is stored then transferred back to the server via a separate device so the invention is not limited to wireless as argued by the applicant.

Applicant asks for clarification of whether the examiner is relying upon para 0090 of Kesling in making the rejection. As noted above the examiner does not limit the teachings to only a select paragraph or line in the specification, but for the convenience



to the applicant, specific columns and lines are provided. Please note that the examiner's position was affirmed and that the Board provided clarification to the issue involving the term "purchase". Therefore, Applicant may consider para 0090 and the comments made by the board as part of the current and subsequent rejection. It is further noted that no specific argument is raised about the teachings of Kesling in regards to the term "purchase" so no specific response is contemplated at this time.

Applicant's amendment has overcome the USC 112 rejection and this rejection has been removed.

Applicant attempts to define what "purchase request" means in page 6 of applicants remarks, the examiner has reviewed the specification and claims and does not find a specific disclosure for the term "purchase request" which was added in the amendment filed 2/7/2005, for purposes of prosecution this term will defined as any means that provides an indication that a user wishes to order a product. Applicant refers to para 9 and 18 when indicating support for "purchase request" but neglected to provide para 26 which also provides disclosure for the phrase "purchase request" and appears to limit the indication to only the pressing of a button.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is established from knowledge generally available to one of ordinary skill in the art. The motivation being the well established marketing principle of impulse buying that results in increased sales.

In response to applicant's argument that Kesling and Borovoy are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Borovoy and Kesling are involved in sales conducted over a wireless connection utilizing a unique identifier to allow a remote site to recognize the user and process a request without further interaction from the user.

Applicant argues that the combination of Kesling and Borovoy do not teach claim 1 because the combination does not teach when the indication is made, an order is placed. First Kesling teaches that during the receipt of broadcast information a button 1220 can be pressed and information identifying the product (program identifier and unique user information) is sent to the website where the web site can respond without further interaction from the user (Kesling para 0064 and 0065). Next applicant is directed to Borovoy teachings that when a recipient of information receives purchase data on a wireless device he may order the product with a single confirming click (para 0030). The combination of these features resulting in the predictable result of a product being ordered on a wireless device with a single interaction that requires no further interaction from the user.

Applicant once again argues the enablement of Kesling's purchasing. This argument was addressed by the Board in the Board decision mailed 7/2/2007 and need not be further argued by the examiner at this time.

#### **Traversal of claim 14**

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments

as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300** [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

**571.272.3600**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Primary Examiner, Art Unit 3625